

Notice of Allowability	Application No.	Applicant(s)	
	09/455,806	BEEZER ET AL.	
	Examiner	Art Unit	
	Hanh B Thai	2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the RCE filed December 22, 2003.
2. ☒ The allowed claim(s) is/are 1-20,25 and 26.
3. ☒ The drawings filed on 12/7/99 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>5/26/04 & 7/19/04</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

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This is in response to the RCE filed December 22, 2003 in which claims 1-20 and 25-26 are present for examination.

DETAILED ACTION

Response to Arguments

Applicant's arguments, filed December 22, 2003, with respect to amended claims 1-20 and 25-26 have been fully considered and are persuasive. The rejection of the claims has been withdrawn.

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

Related Applications

This application is related to the following applications filed herewith:

U.S. Serial No. 09/456,127 (BW 03797.80027), filed December 7, 1999, entitled "Bookmarking and Placemarking a Displayed Document in a Computer System;"

U.S. Serial No. 09/455,754 (BW 03797.84619), filed December 7, 1999, entitled "Method and Apparatus Installing and Using Reference Materials In Conjunction With Reading Electronic Content;"

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U.S. Serial No. 09/455,807 (BW 03797.84618), filed December 7, 1999, entitled "Method and Apparatus for Capturing and Rendering Text Annotations For Non-Modifiable Electronic Content;"

U.S. Serial No. 09/455,808 (BW 03797.84809) filed December 7, 1999 entitled "system, Method, and User Interface for Active Reading of Electronic Content;" and

U.S. Serial No. 09/455,805 (BW 03797.78802), filed December 7, 1999, entitled "system and Method for Annotating an Electronic Document Independently of Its Content."

Allowable Subject Matter

2. Claims 1-20 and 25-26 are allowed over the prior art of record.

3. The following is an examiner's statement of reasons for allowance:

Regarding independent claims 1, 9, 11, 19, 25 and 26, the prior art fails to disclose or suggest the claimed provision "receiving user input for providing an annotation associated with the selected object; the annotation being modifiable; determining a position of the selected object in the non-modifiable portion of the file; storing the position and the annotation separately from the non-modifiable portion of the file; and providing a portion of said display configured for navigating to the previously selected object based on the position, when said annotation is subsequently selected." as claimed in conjunction with remaining claims provisions.

4. The dependent claims, being further limiting to the independent claims, definite and enabled by the Specification are also allowed.

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Comments

5. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Other Prior Art Made of Record

6. DeRose et al. (US 5,557,722) disclose a data processing system and method for representing, generating a representation of and random access rendering of electronic documents.

Boguraev (US 5,799,268) discloses method for extracting knowledge from online documentation and creating a glossary, index, help database or the like.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Point of Contact

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh B Thai whose telephone number is 703-305-4883 and 571-272-4029 after October 21, 2004. The examiner can normally be reached on 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hanh Thai *HT*
Art Unit 2171
September 3, 2004



UYEN LE
PRIMARY EXAMINER

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